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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,539	07/22/2002	Heinrich Gers-Barlag	Beiersdorf 759-HCL	6360
7590 10/20/2004			EXAMINER	
Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 10/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,539

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date July 23, 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 23, 2004 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1–5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag (WO 98/42300) in view of Msika (US 5939054) and Plaschke (US 6409996 B1).

Gers-Barlag teaches an emulsifier-free water-in-oil type cosmetic composition comprising an oil phase, a water phase, and one or more types of micronized, inorganic metal oxides having amphiphilic properties, and other cosmetic additives. See abstract.

Gers-Barlag fails to teach phyllosilicate and flavones, flavonoids, or flavanones.

Msika teaches water-in-oil sunscreens comprising titanium and/or zinc oxide particles. The reference teaches that no additional emulsifiers are added. See col. 2, lines 1 –9. The reference teaches using a modified phyllosilicate, montmorillonites of the bentone for stabilizing the composition, and shows a formulation

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comprising 0.1-5 % by weight of Bentone 38. See col. 3, lines 49 –55; col. 4, lines 24 – 30; col. 9, line 55 – col. 10, line 14. See instant claims 4 and 11. The example shown in col. 8, lines 50 – 66 shows 0.5% by weight of alpha-tocopherol acetate, an antioxidant. The reference further teaches that flavonoids also can be used as an antioxidant, which provides the specific motivation to use flavonoids. See col. 5, lines 41 – 46. See instant claims 5 and 12. The reference teaches using titanium dioxide treated with alkylsilane or aluminum hydroxide and stearic acid. See col. 2, lines 1 – 37; instant claims 7, 9 and 10.

Plaschke teaches a flavonoid-containing sunscreen composition. See abstract. The invention comprises at least one flavanone and at least one flavone, and is said to provide optimized UV-absorption profile. See col. 2, line 21 – col. 4, line 62.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Barlag by adding the phyllosilicate as motivated by Msika because 1) both references teach cosmetic water-in-oil emulsion compositions; 2) Msika teaches the stabilizing effect of the phyllosilicates; 3) and therefore the skilled artisan would have had a reasonable expectation of successfully producing a stable emulsion. The skilled artisan would have been motivated to further add flavonoid as motivated by Msika and Plaschke because 1) both Msika and Paschke teach sunscreens compositions; 2) Msika teaches that flavonoids are antioxidants well known in cosmetic art; and 3) Paschke teaches that flavonoids-containing sunscreen compositions provide optimized UV-absorption; 4) and

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the skilled artisan would have had a reasonable expectation of successfully producing a water-in-oil sunscreen composition with optimized UV protection.

Claims 13–20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag, Msika, and Plaschke as applied to claims 1-5 and 7-12 as above, and further in view of Suzuki et al. (US 5145781).

The combined references fail to teach the flavone as recited in claims 13-20.

Suzuki teaches that alpha-glycosyl rutin has good water-solubility, resistance to light and stability to intact rutin. See abstract. The reference teaches “alpha-glycosyl rutin is favorably usable as a yellowing agent, antioxidant, stabilizer, fading-preventing agent, quality-improving agent, preventive, remedy, uv-absorbent, and deterioration-preventing agent in . . . cosmetics including skin-refining agent and skin-whitening agent”. See abstract. Examples B-9, B-13, B-14. and B-15 shows examples of topical compositions comprising alpha-glycosyl rutin. Example B-14 particularlry teaches an emulsion.

Given the teaching of using flavone in cosmetic composition in the combined references, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Suzuki and have been motivated to use alpha-glycosyl rutin because of the expectation of successfully producing a cosmetic composition with UV protection, skin-refining and skin-whitening effects and enhanced stability.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 8, 10, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 17, 19, 20, 23-25, and 31 of copending Application No. 09/640,822. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of the claims are directed to water-in-oil emulsions comprising a water phase, an oil phase, and at least one modified amphiphilic phyllosilicate particles with overlapping limitations. The limitations on the emulsifiers and the absence thereof are also met.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed December 29, 2003 have been fully considered but they are not persuasive.

Applicants assert that the use of flavone/flavanone/flavonoid compounds is disadvantageous. The evidence to the contrary is provided in the prior art reference:

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Msika and Plaschke reference specifically teaches to use flavones in cosmetic compositions. Applicants' assertion that "Examiner has not provided the factual basis as to why the applicants' [sic] teachings are not thought to be true" is erroneous and it appears that the objective factual teachings in the prior arts are not taken into consideration.

The fact that water-in-oil system has an aqueous phase and an oil phase is not a presumption but a fact any ordinary skill in the art would know. The present rejection is made under obviousness standard in view of the collective teachings of the references generally available to routineers in cosmetic art. The rationale and motivation to combine the references are set forth in the rejection.

Applicants' assertion that the rejection "becomes ever more progressively weaker" is without evidence and unpersuasive. The rejections are supported by objective teachings of the analogous prior arts and the motivations to combine the references are found in the references themselves. In order to overcome the prima facie case of obviousness, applicants are asked to provide arguments supported facts to show specifically why the motivations to combine the references as stated above are not proper, or why the claimed invention is nonobvious in view of the specific facts that are discussed above.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.


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The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina C. Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER